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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,382	09/30/2003	Corinne Bortolin	16222U-016700US	9159
66/945 7590 11/09/2010 TOWNSEND AND TOWNSEND CREW LLP TWO EMBARCADERO CENTER, 8TH FLOOR SAN FRANCISCO, CA 94111				
EXAMINER				
LASTRA, DANIEL				
ART UNIT		PAPER NUMBER		
3688				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/676,382

Applicant(s)

BORTOLIN ET AL.

Examiner

DANIEL LASTRA

Art Unit

3688

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-32, 34-37 and 39-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-32, 34-37 and 39-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 21-32, 34-37 and 39-48 have been examined. Application 10/676,382 (SYSTEM AND APPARATUS FOR LINKING MULTIPLE REWARDS PROGRAMS TO PROMOTE THE PURCHASE OF SPECIFIC PRODUCT MIXES) has a filing date 09/30/2003.

Response to Amendment

2. In response to Final Rejection filed 02/16/10, the Applicant filed an RCE on 05/19/10, which amended claims 21, 25, 28, 32, 35, cancel claims 33, 38 and added new claims 43-48.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 45 recites the limitation "the special program". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 21-23, 25-26, 28-29, 32, 35-36, 39, 41-44 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler (US 2002/0026348) in view of Fernandez (US 2001/0016827).

Claims 21, 32 Fowler teaches:

A method comprising: receiving information at a host server computer about a first pre-existing reward program created by a first merchant, wherein the first pre-existing offline reward program provides for a first reward when a first product is purchased at the first merchant (see paragraphs 19-20);

receiving information at the host server computer about a second pre-existing reward program created by a second merchant, wherein the second pre-existing reward program provides a second reward when a second product is purchased at the second merchant (see paragraph 31); and

using the host server computer, providing for a combination reward program that is linked to the first pre-existing reward program and the second pre-existence reward program and that provides a combination reward that is based on the purchase of at least the first product and the second product, wherein the combination reward program is provided by a reward sponsor, wherein the first merchant is different than the second merchant (see paragraph 26-31), and wherein the combination reward is given to a consumer if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location (See paragraphs 26-31, 83);

Fowler does not teach and wherein the first pre-existing offline reward program is capable of running without being in contact with the host server computer, and wherein the second pre-existing offline reward program is capable of running without being in contact with the host server computer. However, Fernandez teaches an offline loyalty

program where all loyalty transaction of debiting or crediting a smart card are performed at point of sale terminal (i.e. offline) without the need to contact a host server (see paragraph 23-24, 27). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that because Fowler smart cards may host a transaction processing module previously hosted by a host server (see paragraph 58) and because Fowler accommodates instances when communication with host system is not possible by performing a loyalty transaction at the point of sale terminal (see paragraph 70) that Fowler would modify his invention to download loyalty parameters to POS terminals, as taught by Fernandez in order to add the feature of not needing to contact a host server (i.e. offline) in order to perform a loyalty transaction of crediting or debiting a smart card.

Claim 22, Fowler teaches:

providing the combination reward to the consumer at the first merchant at the first location, wherein the combination reward can be used at the second merchant at the second location (see paragraph 105).

Claim 23, Fowler teaches:

wherein the portable consumer device is a smart card and wherein the combination reward is in the form of a coupon (see paragraph 40, 83).

Claim 25, Fowler teaches:

wherein the combination reward program is created by the reward sponsor that is affiliated with the first merchant and the second merchant (see paragraph 22).

Claim 26, Fowler teaches:

wherein the combination reward program reduces or eliminates the combination reward, if a third product that is different than the first product and the second product, is purchased (see paragraph 19).

Claim 28, Fowler teaches:

wherein the one or more digital computers comprises a server computer, and wherein the method further comprises:

sending code for the combination reward program to a first access device operated by the first merchant and a second access device operated by the second merchant (see paragraph 28).

Claim 29, Fowler teaches:

wherein the first product and the second product are made by the same manufacturer (See paragraph 82 “brand”).

Claim 35, Fowler teaches:

wherein the combination reward program is created by the host organization that is affiliated with the first merchant and the second merchant (see paragraph 22).

Claim 36, Fowler teaches:

wherein the combination reward program reduces or eliminates the combination reward, if a third product that is different than the first product and the second product, is purchased (see paragraph 19).

Claim 39, Fowler teaches:

wherein the method further comprises:

sending code for the combination reward program to a first access device operated by the first merchant and a second access device operated by the second merchant (see paragraph 53-54).

Claims 41-42, Fowler teaches:

wherein the combination reward is of greater value than the first reward or the second reward (See paragraph 75).

Claim 43, Fowler teaches:

wherein the host server computer is hosted by a credit card processing company (see paragraph 19 "institution").

Claim 44 Fowler teaches:

wherein the reward sponsor is a credit, debit, or smart card issuer (see paragraph 65 "merchant is an institution").

Claim 46 Fowler teaches:

wherein the portable consumer device is a mobile phone with a microprocessor that communicates with a card acceptance device (See paragraph 68).

Claim 47 Fowler teaches:

wherein each portable consumer device is associated with a different consumer (See paragraph 17).

Claim 48 Fowler teaches:

wherein each portable consumer device is embossed with consumer identification information (see paragraph 17).

6. Claims 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler (US 2002/0026348) in view of Ryan (US 2005/0055272).

Claim 24, Fowler does not teach:

wherein the combination reward is an extension of time to receive at least one of the first reward and the second reward. However, Ryan teaches that it is old and well known in the promotion art to extend the expiration date of a reward (i.e. cash value coupon) when said reward is offered in combination with another reward (i.e. joint a private club as a reward) (see paragraph 52). Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Fowler would offer coupon rewards with an extension of time, when said coupon rewards are offered with a combination of another product, as the claimed invention is simply a combination of old elements and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

7. Claims 27, 34, 37 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler (US 2002/0026348) in view of Nerger Monika, Evening the odds: CRM systems are driving sophisticated loyalty programs at Las Vegas Casinos - and not just for the high rollers, March 1, 2002.

Claims 27, 34 and 37, Fowler does not teach:

wherein the combination reward gives the consumer access to a special program earlier than another consumer that has not purchased the first product and the second product. However, Evening the odds teaches that it is old and well known in the

promotion art to have loyalty programs where a customer receives preferential treatment, such as access to transportation earlier in time than other customers (i.e. not need to wait in line) when said customer earned enough loyalty points to achieve a specific tier level (see page 1). Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Fowler would offer a customer that has purchased two products access to special programs earlier than other customers that had not purchased said two products and had not earned enough loyalty points, as the claimed invention is simply a combination of old elements and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 45, Fowler does not teach:

wherein the special program is a reward program provided by a credit card processing company. However, Evening the odds teaches that it is old and well known in the promotion art to have loyalty programs (i.e. payment card or loyalty card) where a customer receives preferential treatment, such as access to transportation earlier in time than other customers (i.e. not need to wait in line) when said earned enough loyalty points to achieve a specific tier level (see page 1). Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Fowler would offer a customer that has purchased two products access to special programs earlier than other customers that had not purchased said two products and had not earned enough loyalty points, as the claimed invention is simply a

combination of old elements and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

8. Claims 30-31 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler (US 2002/0026348) in view of Postrel (US 6,594,640).

Claims 30-31, Fowler teaches:

wherein the portable consumer device is a smartcard (see paragraph 83) but does not expressly teach that conforms to ISO standard 7816, wherein the smartcard includes a dynamic data field that is updated each time the first, second, and combination reward programs accumulate or redeem rewards. However, Postrel teaches that it is old and well known in the promotion art to stored rewards from a loyalty program in smart cards (see col 9, lines 55-65) and Official Notice is taken that it is old and well known to have smart cards that conforms to ISO standard 7816. Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Fowler would store rewards on smart cards, as taught by Postrel that conforms to ISO standard 7816, as the claimed invention is simply a combination of old elements and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN WEISS can be reached on (571) 272-6812. The official Fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/
Primary Examiner, Art Unit 3688
November 6, 2010